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EXAMINER

TOPGYAL, GELEK W

ART UNIT	PAPER NUMBER
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2621

MAIL DATE	DELIVERY MODE
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12/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/930,756	Applicant(s) WAKAHARA, TATSUYA	
	Examiner GELEK TOPGYAL	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,8-10,12-14,18-25,28,31,32,34 and 55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8-10,12-14,18-25,28,31,32,34 and 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/5/2008 has been entered.

Response to Arguments

2. Applicant's arguments filed 10/24/2008 have been fully considered but they are not persuasive.

In re pages 11-12, the applicants argue that the newly added limitation of "said analyzing means is based on the type of content included in the program and the format of the content included in the program".

In response, the examiner respectfully disagrees. Given the broadest interpretation, the newly added limitation of "type of content" and "format of the content" are met by the corresponding portions in col. 6, lines 16-26 which discloses two sets of information about that program to be recorded in 1) configuration bits 52 and 50 and the 2) pay-to-tape allowed/prohibited bits in Table 1. The configuration bits 52 and 50 meet the claimed "type of content" as claimed and the pay-to-tape allowed/prohibited bits in Table 1 meets the claimed "format of content" as claimed.

Claim Rejections - 35 USC § 102

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. **Claims 1-2, 5-6, 9, 10, 13, 14, 18-23, 25, 32, 34 and 55** are rejected under 35 U.S.C. 102(e) as being anticipated by Wonfor et al. (US 6,381,747).

Regarding claim 1, Wonfor et al. teaches an information processing device, characterized by comprising:

judging means for judging whether restriction on recording is imposed on a program which a user desires to watch and listen to (Tables 1-2 and col. 5, line 58 through col. 6, line 26 teaches a conditional access system module 38 that receives copy protection control information. The CPU 40 then controls the con access system module 38 to determine the contents of the copy protection control information);

analyzing means for analyzing the restriction if it is judged by said judging means that the restriction on recording is imposed on the program (Tables 1-2 and col. 5, line

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58 through col. 6, line 26 teaches a conditional access system module 38 that receives copy protection control information. The CPU 40 then controls the conditional access system module 38 to determine the contents of the copy protection control information); and

display control means for controlling a display to display on a screen a message concerning an analysis result of said analyzing means, (Col. 11, line 45+ teaches that a user interacts and "selects the "pay-to-tape option"". It's inherent that a pay per view service has a GUI, and with the ability of the user to select an option to pay to record a PPV program, a message concerning the payment has to have been displayed as well);

said analyzing is based on the type of content included in the program and the format of the content included in the program (the limitation of "type of content" and "format of the content" are met by the corresponding portions in col. 6, lines 16-26 which discloses two sets of information about that program to be recorded in 1) configuration bits 52 and 50 and the 2) pay-to-tape allowed/prohibited bits in Table 1. The configuration bits 52 and 50 meet the claimed "type of content" as claimed and the pay-to-tape allowed/prohibited bits in Table 1 meets the claimed "format of content" as claimed. With the analysis of the configuration bits 52 and 50 and the pay-to-tape allowed/prohibited bits in Table 1, the system of Wonfor et al. is capable of determining the type of copy protection that is applicable for a particular program).

Regarding claim 2, the system of Wonfor et al. teaches the limitations as discussed in claim 1 above, furthermore, Wonfor et al. teaches the claimed wherein in accordance with each of a case where said analyzing means determines that analog recording is released by paying an additional fee (Col. 11, line 45+ teaches that a user

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interacts and “selects the “pay-to-tape option””. It’s inherent that a pay per view service has a GUI, and with the ability of the user to select an option to pay to record a PPV program, a message concerning the payment has to have been displayed as well. In order for the customer to purchase or cancel the recording, buttons/symbols (e.g. “Yes”, “No” buttons) must be displayed so that the customer can select that particular function.), a case where said analyzing means determines that analog recording is allowed, but digital recording is not allowed (as discussed above, and additionally, Wonfor only allows the programs to be stored in a magnetic tape and teaches in Fig. 2, between elements 10 and 24, that the video to be recorded is an analog video output) and a case where said analyzing means determines that neither analog recording nor digital recording is allowed, said display control means controls the display on the screen to make the user recognize the respective cases (Col. 11, lines 45-53 and Table 2 teaches situations where any type of recording of the program is prohibited, therefore, a digital copy and analog copies are prohibited altogether).

Claims 5-6 and 9-10 are rejected for the same reasons as discussed above in claims 1 and 2, respectively, because a device inherently uses methods to accomplish its’ tasks.

Claim 13 is rejected for the same reasons as discussed in claim 1 above, and additionally, Wonfor et al. teaches a display (Fig. 2, TV displays 22 and 28), and teaches a microcontroller (met by CPU 40 in the discussion of claim 1 above).

Regarding claim 14, the system of Wonfor et al. teaches the limitations as discussed in claim 13 above, and furthermore, Wonfor et al. teaches in Fig. 2 of a Digital PPC Set Top Box 10 that receives the broadcast programs.

Regarding claim 18, the system of Wonfor et al. teaches the limitations as discussed in claim 13 above, and furthermore, Wonfor et al. teaches the claimed wherein said display is adapted to display said program (Fig. 2, TV 22) and said instructions further comprise instructions for causing said processor to perform said identifying, said analyzing and said controlling steps before said display of said program (A CPU 40 processes the copy control information (as discussed above in claim 13) before the program is displayed. In a PPV service, the conditions as listed in Table 2 are processed prior to the viewing/recording of the program).

Regarding claim 19, the system of Wonfor et al. teaches the limitations as discussed in claim 13 above, and furthermore, Wonfor et al. teaches the claimed wherein said program requires paying money for said display of said program (Col. 11, lines 45-54 teaches that a user is billed for purchasing a program for a display purpose).

Regarding claim 20, the system of Wonfor et al. teaches the limitations as discussed in claim 13 above, and furthermore, Wonfor et al. teaches the claimed wherein said system further comprises a recorder adapted for copying said program (A recorder 24 in Fig. 2 is adapted to copy the program.) and said instructions further comprise instructions for causing said processor to perform said identifying, said analyzing and said controlling steps before said copying of said program (A CPU 40 processes the copy control information (as discussed above in claim 13) before the

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program is displayed. In a PPV service, the conditions as listed in Table 2 are processed prior to the viewing/recording of the program).

Regarding claim 21, the system of Wonfor et al. teaches the limitations as discussed in claim 13 above, and furthermore, Wonfor et al. teaches the claimed wherein said program requires paying money for said copying of said program (Col. 11, lines 53-65 teaches that a user is billed for purchasing a program for a recording purpose).

Regarding claim 22, the system of Wonfor et al. teaches the limitations as discussed in claim 13 above, and furthermore, Wonfor et al. teaches the claimed wherein said instructions further comprise instructions for causing said processor to perform the step of controlling said display to display a menu containing interactive prompts for receiving said person's input (As discussed in claim 13 above (via claim 1), an inherent feature of a PPV purchase transaction includes a GUI interface, which has menus and interactive prompts).

Regarding claim 23, the system of Wonfor et al. teaches the limitations as discussed in claim 13 above, and furthermore, Wonfor et al. teaches the claimed wherein said prompts include a prompt for said person to acknowledge the presence of said copy-protected data within said program (As discussed above in claim 13 (via claim 1), when a user decides to purchase the ability to copy the program, he has acknowledged the copy protection information).

Claim 25 is rejected for the same reasons as discussed in claim 18 above, since user can pay to view or record the program.

Claim 32 is rejected for the same reasons as discussed in claim 13 above, when the display shows the options to select a program for viewing/recording, the system has been controlled to display the copy protection information.

Claim 34 is rejected for the same reasons as discussed in claim 13 above, because a device inherently uses methods to accomplish its' tasks.

Claim 55 is rejected for the same reasons as discussed in claim 13 above, because a device inherently uses methods to accomplish its' tasks.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 4, 8, 12 and 31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wonfor et al. (US 6,381,747) in view of Tsutsumi (US 5,737,477).

Regarding claim 4, the system of Wonfor et al. teaches the limitations as discussed in claim 1 above, furthermore, Wonfor et al. teaches a system where the copy protected information is displayed on the screen, but fails to particularly teach that the message is displayed for a predetermined time.

In an analogous art, Tsutsumi teaches of a system where a message displayed to a user via a display unit is removed from the display unit after a certain period of time (col. 5, lines 36-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to display a message on a display unit for only a predetermined time to increase user friendliness so that the user can continue to watch the program that was disturbed due to the display of the message.

Claim 8 is rejected for the same reasons as discussed above in claim 4 because a device inherently uses methods to accomplish its' tasks.

Claim 12 is rejected for the same reasons as discussed above in claim 4.

Regarding claim 31, the system of Wonfor et al. teaches the limitations as discussed in claim 13 above, furthermore, Wonfor et al. teaches a system where the copy protected information is displayed on the screen, but fails to particularly teach that the message is displayed for a predetermined time.

In an analogous art, Tsutsumi teaches of a system where a message displayed to a user via a display unit is removed from the display unit after a certain period of time (col. 5, lines 36-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to display a message on a display unit for only a predetermined time to increase user friendliness so that the user can continue to watch the program that was disturbed due to the display of the message.

7. **Claim 24** is rejected under 35 U.S.C. 103(a) as being unpatentable over Wonfor et al. (US 6,381,747) in view of Alten et al. (US 5,781,246).

Regarding claim 24, the system of Wonfor et al. teaches the limitations as discussed in claim 22 above, furthermore, Wonfor et al. teaches that a program can be viewed and recorded, but fails to specifically teach that while watching a program, the user has the ability to cancel viewing the program or cancel displaying of said information.

In a related art, Alten et al. teaches that while watching a certain channel, a user can change the channel by entering a channel number by way of a keypad or by using channel up/down buttons. When the user changes the channel, the program being viewed is no longer displayed on the screen, and thereby cancelled for viewing (col. 12, lines 43-54).

A user is able to maneuver through numerous channels by way of a remote control with channel changing buttons. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the ability to change channels into Wonfor et al.'s system to increase user friendliness by giving the user an option to watch what he wants at any given time.

8. **Claim 28** is rejected under 35 U.S.C. 103(a) as being unpatentable over Wonfor et al. (US 6,381,747) in view of Horlander et al. (US 6,507,953).

Regarding claims 28, Wonfor et al. teaches in his system of prohibiting recording of desired programs, but he fails to expressly disclose that the recording can be of analog or digital format.

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Horlander teaches in col. 10, lines 14-42 of copyright data that prohibits the following recordings: digital (33h), analog (31h), and neither digital nor analog (34h). Having a digital copy of a program allows a user to make non-deteriorating copies. Such a situation is unfavorable from the viewpoint of copyrights. The quality of an analog copied program will not be long lasting, and thereby inhibit more copies made in future due to the deteriorating data stored on the magnetic tapes. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Wonfor et al. to classify the type of allowable recordings into analog, digital, and neither.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GELEK TOPGYAL whose telephone number is (571)272-8891. The examiner can normally be reached on 8:30am -5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gelek Topgyal/
Examiner, Art Unit 2621

/Thai Tran/
Supervisory Patent Examiner, Art Unit 2621